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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,831	12/07/2001	Joseph A. Manico	83565SLP	5035

7590
Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-4027

07/06/2007

EXAMINER

HANNETT, JAMES M

ART UNIT	PAPER NUMBER
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2622

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/017,831

Applicant(s)

MANICO ET AL.

Examiner

James M. Hannett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7,9-11,13-22 and 24 is/are allowed.
- 6) ☒ Claim(s) 1,23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/5/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, see pre-appeal brief request, filed 3/22/2007, with respect to claims 10,11,13-15 and 24 have been fully considered and are persuasive. Therefore, The finality of previous office action has been withdrawn.

Applicant's arguments filed 3/22/2007 related to claims 1,23 and 25-27 have been fully considered but they are not persuasive. The applicant argues that the fact that the imaging system of Ueda et al teaches that the imaging system is movable using the depicted wheels does not indicate portability. The examiner disagrees with the applicant. Clearly the imaging system of Ueda et al was designed to have wheels because it was desirable to make the system movable. Furthermore, although this system is not small enough to be moved by hand, the examiner took Official Notice that it would have been notoriously obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the imaging system of Ueda et al in order to make it small enough to be carried by hand. The examiner asserts that Ueda et al discloses the claimed invention except for being hand held and portable. It would have been an obvious matter of design choice to make the imaging system of Ueda et al small enough to be carried by hand, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Furthermore, the examiner asserts that it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1: Claims 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN

6,429,923 Ueda et al.

2: As for Claim 26, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of producing a print from a visual image (printing out images), comprising the steps of: transporting a portable imaging system to a first location; The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image. This is viewed by the examiner as scanning the hard copy document at the first location using the portable imaging system to produce a digital image. The system is viewed by the examiner to be portable as a result of the wheels depicted in Figure 3. Ueda et al further depicts in Figures (3

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and 5) that the portable photofinisher (600) is provided with wheels (302). Although the specification of Ueda et al does not specifically discuss the wheels or when the photofinisher will be moved, It is clear from in Figures (3 and 5) that the photofinisher is inherently designed to be moved from a first location to a second location.

3: As for Claim 27, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image. The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image. This is viewed as accessing the image to be digitized at the second location and scanning the image at the second location using the portable imaging system to produce a digital image. Ueda et al teaches on Column 36, Lines 32-60 and Column 37, Lines 34-50 that the scanned image is digitized and stored in memory. Furthermore, Ueda et al teaches generating an order request associated with the stored digital image.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4: Claims 1, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over
USPN 6,429,923 Ueda et al.

5: As for Claim 1, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image, comprising the steps of: The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the second location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the second location (photo-shop) using the portable imaging system to produce a digital image; Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is viewed as the service provider receives an order request associated with the digital image from the user. Furthermore, Ueda et al depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center or a truck will arrive at the photo-shop and pickup the images and bring them to the photo-finishing processing center. This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing

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center) for fulfillment of the order request. The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. However, Ueda et al does not discuss the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to be hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enable the device to be easily moved by hand.

6: As for Claim 23, Claim 23 is rejected for reasons discussed related to Claim 1.

7: As for Claim 25, Claim 25 is rejected for reasons discussed related to Claim 1.

Allowable Subject Matter

8: Claims 2-7, 9-11, 13-22 and 24 are allowed

The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not teach the method of transporting a portable imaging system to a first location; receiving a hardcopy document from a user at the first location, the hard copy document containing the visual image; scanning the hard copy document at the first location using the portable imaging system to produce a digital image; and transporting the portable imaging system to a second location remote from the first location. Furthermore, the prior art

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does not teach the method of sequentially transporting a portable imaging system from a first location; accessing the image to be digitized at the second location; scanning the image at the second location using the portable imaging system and storing the digital image in memory disposed in the portable imaging system and generating an order request associated with the stored digital image.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hannett whose telephone number is 571-272-7309. The examiner can normally be reached on 8:00 am to 5:00 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on 571-272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James M. Hannett
Examiner
Art Unit 2622



JMH
July 2, 2007